

Serial No. 09/910,220
Atty. Doc. No. 01P12721US

REMARKS

Claims 22-26 are pending in the application. In view of the following remarks, Applicant respectfully requests favorable reconsideration and allowance of the pending claims.

Rejection of Claims 22-26 Under § 103

Claims 22-26 have been rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 5,177,385 ("Cooper"); U.S. Patent No. 4,342,336 ("Satterthwaite"); and U.S. Patent No. 4,654,550 ("Lowther"). Applicant respectfully traverses the rejection.

Applicant respectfully submits that the Examiner's rejections are based on impermissible hindsight reconstruction of Applicant's invention. In this regard, Applicant respectfully submits that the Examiner has picked and chosen specific elements of Applicant's invention from various prior art references and combined them without a specific suggestion or motivation from the references to do so.

Virtually all inventions are combinations of old elements. Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be an illogical and inappropriate process by which to determine patentability.

In re Rouffet, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998).

To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

Ex parte Clapp, 227 USPQ 972, 973 (BPAI 1985).

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Applicant also respectfully submits that the combination of Cooper, Satterthwaite and Lowther proposed by the Examiner is not technically feasible. Cooper specifically teaches that its "air gap baffle ring is composed of two composite rings 47 having a seal material 50 sandwiched between and then bonded into a single ring." (col. 3, lines 35-37). This arrangement would not technically permit inclusion of an expandable seal such as the one disclosed in Satterthwaite. If the expandable seal of Satterthwaite were bonded into a single ring, as taught by Cooper, it would no longer be expandable, defeating the purpose of including an expandable seal.


CONCLUSION

In light of the above remarks, Applicant respectfully requests favorable reconsideration and allowance of pending claims 22-26. The application is now believed to be in condition for allowance and such action is respectfully requested. Should the Examiner have any questions concerning this paper or application, or if any issues remain, the Examiner is respectfully requested to contact Applicant's undersigned attorney to resolve such issue or question.

The commissioner is hereby authorized to charge any appropriate fees due in connection with this paper or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

Dated: 1/19/04

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